

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the foregoing amendments and the following remarks.

Claims 12-28 are pending in the patent application, of which claims 12, 15, 18, 19 and 24 are independent.

With appreciation, it is noted that the Office Action indicates (see present Office Action page 9) claims 21-22 as containing allowable subject matter and claims 24-28 as allowed. Claims 21-22 are rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Noted – Priority Document Received by USPTO

The indication (see attachments to the Office Actions mailed March 19, 2004, box 12(a)(1) as checked) that certified copy of the priority document has been received by the USPTO is noted with application.

Noted – IDS considered

The indication (see attachments to the Office Actions mailed, March 19, 2004, December 13, 2005, February 21, 2007, April 16, 2007 and October 22, 2007) that the Information Disclosure Statements (IDS) as filed on February 9, 2000, September 27, 2005, June 7, 2006, October 30, 2006, July 17, 2007 and September 4, 2007 and references listed therein have been considered is noted with application.

Approval of Drawings Requested

Drawings were submitted on February 10, 2000. To date, no official indication of approval of the drawings has been noted in the prosecution history. The undersigned has no reason to believe that this circumstance implies anything other than a minor oversight on the part of the USPTO. Accordingly, official approval of the drawings is hereby respectfully requested.

Claim Objection

Claims 18, 19 and 21 are objected to because of the informalities. By the foregoing amendments, these claims have been amended to address the objection to the claims. Accordingly, withdrawal of the objection to the claims is respectfully requested.

Claim Rejection Under 35 U.S.C. §101

Claim 18 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. In particular, the Office Action asserts that the claimed invention is directed to non-statutory subject matter. By the foregoing amendments, this claim has been amended to address the rejection to the claim. Accordingly, withdrawal of the rejection to the claim is respectfully requested.

Claim Rejection Under 35 U.S.C. §102

Claims 12, 13, 19 and 23 are rejected under 35 U.S.C. §102(e) as being anticipated by Kosaka (US 6,574,209 B1).

INDEPENDENT CLAIM 12

As an example, independent claim 12 recites (among other things) a feature of:

...

measuring communication performances of communication between the communication device and the other communication device by communicating between the communication device and the other communication device in each of the plurality of different communication modes, under a plurality of different communication conditions for each of the different communication modes respectively, before performing actual communication;

Kosaka discloses "At step S1, the communication speed (data transmitting speed) is set at 64 kbps. At step S2, the portable telephone device is brought to a dual mode, in which both voice communication and image communication are performed. Namely, the voice of party A using this portable telephone is fed into the device through the microphone 6, and the video image of party A is fed into the device through the camera 9. The voice of the other party B is heard through the speaker 5, and the image of party B is shown on the display 8 (Kosaka; col. 4, ll. 47-56, Fig. 1)." Kosaka also discloses "When the transmitting amplifier temperature exceeds the first temperature during operation at the high speed, the communication speed is automatically switched to a low speed, e.g., 8 kbps to avoid overheating of the device. After the transmitting amplifier temperature becomes below a predetermined second temperature that is lower than the first temperature during operation at the low speed, the communication speed is automatically switched again to the high speed (Kosaka; col. 2, ll. 17-27)." Kosaka teaches that the transmitting amplifier temperature is measured not before communication but during communication. Therefore, Kosaka does not disclose "*measuring communication performances of communication between the communication device and the other communication device by communicating between the communication device and the other*

communication device in each of the plurality of different communication modes, under a plurality of different communication conditions for each of the different communication modes respectively, before performing actual communication." Claim 12 discloses "*measuring communication performances of communication between the communication device and the other communication device by communicating between the communication device and the other communication device in each of the plurality of different communication modes, under a plurality of different communication conditions for each of the different communication modes respectively, before performing actual communication.*"

Claims 13 and 23 depend from Claim 12. A basis for how Kosaka is deficient vis-à-vis Claim 12 has been noted above.

Among other things, a *prima facie* case of obviousness must establish that the asserted combination of references teaches or suggested each and every element of the claimed invention. In view of the distinction of Claim 12 noted above, at least one claimed element is not present in the asserted combination of references. Hence, the Office Action fails to establish a *prima facie* case of obviousness vis-à-vis Claims 12. Claims 13 and 23 ultimately depend from claim 12, and so at least similarly distinguish over the asserted combination of references.

INDEPENDENT CLAIM 19

As an example, independent claim 19 recites (among other things) a feature of:

...

measuring a communication performance in the first communication mode, and a communication performance in the second communication mode under each of the different communication conditions, before performing actual communication;

...

Kosaka discloses "At step S1, the communication speed (data transmitting speed) is set at 64 kbps. At step S2, the portable telephone device is brought to a dual mode, in which both voice communication and image communication are performed. Namely, the voice of party A using this portable telephone is fed into the device through the microphone 6, and the video image of party A is fed into the device through the camera 9. The voice of the other party B is heard through the speaker 5, and the image of party B is shown on the display 8 (Kosaka; col. 4, ll. 47-56, Fig. 1)." Kosaka also discloses "When the transmitting amplifier temperature exceeds the first temperature during operation at the high speed, the communication speed is automatically switched to a low speed, e.g.,

8 kbps to avoid overheating of the device. After the transmitting amplifier temperature becomes below a predetermined second temperature that is lower than the first temperature during operation at the low speed, the communication speed is automatically switched again to the high speed (Kosaka; col. 2, ll. 17-27)." Kosaka teaches that the transmitting amplifier temperature is measured not before communication but during communication. Therefore, Kosaka does not disclose "*measuring a communication performance in the first communication mode, and a communication performance in the second communication mode under each of the different communication conditions, before performing actual communication.*" Claim 19 discloses "*measuring a communication performance in the first communication mode, and a communication performance in the second communication mode under each of the different communication conditions, before performing actual communication.*"

Claims 21-22 depend from Claim 19. A basis for how Kosaka is deficient vis-à-vis Claims 19 has been noted above.

Among other things, a *prima facie* case of obviousness must establish that the asserted combination of references teaches or suggested each and every element of the claimed invention. In view of the distinction of Claim 19 noted above, at least one claimed element is not present in the asserted combination of references. Hence, the Office Action fails to establish a *prima facie* case of obviousness vis-à-vis Claims 19. Claims 21-22 ultimately depend from claim 19, and so at least similarly distinguish over the asserted combination of references.

Accordingly, withdrawal of the rejection is respectfully requested.

Claim Rejection Under 35 U.S.C. §103

Claims 14, 15, 18 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kosaka in view of Vembu (US 6,259,928 B1).

Claims 16 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kosaka in view of Vembu and Liu (US 6,252,900 B1).

Claims 14 and 20 depend from Claims 12 and 19, respectively. A basis for how Kosaka is deficient vis-à-vis Claims 12 and 19 has been noted above. The Office Action does not rely upon Vembu to compensate for these deficiencies. Hence, the noted feature of Claims 14 and 20 also is a distinction over Vembu.

Among other things, a *prima facie* case of obviousness must establish that the asserted combination of references teaches or suggested each and every element of the claimed invention. In view of the distinction of Claims 12 and 19 noted above, at least one claimed element is not present in

the asserted combination of references. Hence, the Office Action fails to establish a *prima facie* case of obviousness vis-à-vis Claims 12 and 19. Claims 14 and 20 ultimately depend from claims 12 and 19, respectively, and so at least similarly distinguish over the asserted combination of references.

In view of the foregoing discussion, the rejection of Claims 14 and 19 is improper. Accordingly, withdrawal of the rejection is respectfully requested.

INDEPENDENT CLAIM 15

As an example, independent claim 15 recites (among other things) a feature of:

...

a unit that measures performances of a communication between the communication device and one of the other communication device in each of the different communication modes, under the different communication data sizes respectively, for each of the other communication devices;

a unit that determines, for each of the other communication device, a communication data size that a communication performance of a communication between the other communication device in a first communication mode exceeds a communication performance of communication in a second communication mode and set the determined communication data size as a threshold for the other communication device; ...

As will be explained below, at least these features of claim 15 are a distinction over Kosaka, and thus over its combination with Vembu.

Kosaka discloses "When the transmitting amplifier temperature exceeds the first temperature during operation at the high speed, the communication speed is automatically switched to a low speed, e.g., 8 kbps to avoid overheating of the device. After the transmitting amplifier temperature becomes below a predetermined second temperature that is lower than the first temperature during operation at the low speed, the communication speed is automatically switched again to the high speed (Kosaka; col. 2, ll. 17-27)." However, Kosaka does not disclose the predetermined first temperature and the predetermined second temperature are determined for each of other communication devices. Therefore, Kosaka does not disclose "*a unit that measures performances of a communication between the communication device and one of the other communication device in each of the different communication modes, under the different communication data sizes respectively, **for each of the other communication devices**; a unit that determines, **for each of the other communication device**, a communication data size that a communication performance of a communication between*

the other communication device in a first communication mode exceeds a communication performance of communication in a second communication mode and set the determined communication data size as a threshold for the other communication device." Claim 15 discloses "*a unit that measures performances of a communication between the communication device and one of the other communication device in each of the different communication modes, under the different communication data sizes respectively, **for each of the other communication devices**; a unit that determines, **for each of the other communication device**, a communication data size that a communication performance of a communication between the other communication device in a first communication mode exceeds a communication performance of communication in a second communication mode and set the determined communication data size as a threshold for the other communication device."*

Hence, the noted features of claim 15 are distinction over Kosaka. The noted features also are distinction over Vembu as evidenced, e.g., by the Office Action. That is, the Office Action does not assert Vembu as disclosing the noted features.

Claims 16-17 depend from Claim 15. A basis for how Kosaka is deficient vis-à-vis Claims 15 has been noted above. The Office Action does not rely upon Vembu to compensate for these deficiencies. Hence, the noted feature of Claims 15 also is a distinction over Vembu.

Among other things, a *prima facie* case of obviousness must establish that the asserted combination of references teaches or suggested each and every element of the claimed invention. In view of the distinction of Claim 15 noted above, at least one claimed element is not present in the asserted combination of references. Hence, the Office Action fails to establish a *prima facie* case of obviousness vis-à-vis Claims 15. Claims 16-17 ultimately depend from claim 15, and so at least similarly distinguish over the asserted combination of references.

INDEPENDENT CLAIM 18

As an example, independent claim 18 recites (among other things) a feature of:

...

measuring performances of communication between the other communication device in a plurality of different communication modes under a plurality of different communication conditions respectively, for each of the other communication devices;
determining, for each of the other communication devices, a communication condition that a communication performance of communication between the other

communicating device in one of the communication modes exceeds a communication performance of communication in the other communication mode, for each other of the other communication devices; ...

As will be explained below, at least these features of claim 18 are a distinction over Kosaka, and thus over its combination with Vembu.

Kosaka discloses "When the transmitting amplifier temperature exceeds the first temperature during operation at the high speed, the communication speed is automatically switched to a low speed, e.g., 8 kbps to avoid overheating of the device. After the transmitting amplifier temperature becomes below a predetermined second temperature that is lower than the first temperature during operation at the low speed, the communication speed is automatically switched again to the high speed (Kosaka; col. 2, ll. 17-27)." However, Kosaka does not disclose the predetermined first temperature and the predetermined second temperature are determined for each of other communication devices. Therefore, Kosaka does not disclose "*measuring performances of communication between the other communication device in a plurality of different communication modes under a plurality of different communication conditions respectively, **for each of the other communication devices**; determining, **for each of the other communication devices**, a communication condition that a communication performance of communication between the other communicating device in one of the communication modes exceeds a communication performance of communication in the other communication mode, for each other of the other communication devices.*" Claim 18 discloses "*measuring performances of communication between the other communication device in a plurality of different communication modes under a plurality of different communication conditions respectively, **for each of the other communication devices**; determining, **for each of the other communication devices**, a communication condition that a communication performance of communication between the other communicating device in one of the communication modes exceeds a communication performance of communication in the other communication mode, for each other of the other communication devices.*"

Hence, the noted features of claim 18 are distinction over Kosaka. The noted features also are distinction over Vembu as evidenced, e.g., by the Office Action. That is, the Office Action does not assert Vembu as disclosing the noted features.

Accordingly, withdrawal of the rejection is respectfully requested.

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below.

Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 19-3935.

Respectfully submitted,
STAAS & HALSEY LLP
/Mehdi D. Sheikerz/

Date: _____ November 22, 2010 _____ By: _____

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